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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,079	02/26/2002	Dominik Schutz	TRW(ASG)6052	4699
26294	7590	10/08/2003	EXAMINER	
TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 526 SUPERIOR AVENUE, SUITE 1111 CLEVEVLAND, OH 44114			LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/083,079

Applicant(s)
SCHUTZ

Examiner
Luong

Art Unit
3682



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/30/03.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/26/02 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 7/30/03 is: a) ☐ approved b) ☒ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☒ Other: Attachment

Vinh T. Luong
Primary Examiner

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1. The Amendment filed on July 30, 2003 (Paper No. 7) has been entered.
2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on July 30, 2003 have been disapproved because:

(A) the drawings are inconsistent with the written disclosure. For example, claim 5 calls for a plastic housing 16, however, Figs. 1-5 show that the housing 16 is made of metal in accordance with the drawing symbol for draftspersons in MPEP 608.02; and

(B) applicant does not: (1) show the changes by red ink or highlighted; and (2) embody the proposed amendment of the drawing in a separate letter to the Office draftsperson. See MPEP 608.02(r) and (v).

A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

3. The original drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, the foam casing in claim 1 and the plastic housing in claim 5, etc. must be shown or the features canceled from the claims. No new matter should be entered.

The original Fig. 1 shows that the element 12 is made of sand or the like in accordance with the drawing symbols for draftspersons in MPEP 608.02. Similarly, claim 5 calls for the plastic housing 16, however, the original Figs. 1-5 do not show the drawing symbol for plastic in MPEP 608.02.

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4. The disclosure is objected to because of the following informalities: the specification and the claims are inconsistent with the original drawings. For example, claim 1 claims the foam casing 12, however, the original Fig. 1 shows that the element 12 is made of sand or the like in accordance with the drawing symbols for draftspersons in MPEP 608.02. Similarly, claim 5 calls for the plastic housing 16, however, the original Figs. 1-5 do not show the drawing symbol for plastic in MPEP 608.02. Appropriate correction is required.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-4 and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Bohn et al. cited by applicant (EP 0 945 310 A2 which corresponds to US Patent No. 6,312,012 B1.)

The examiner respectfully submits that in the rejection below, the examiner refers to Pat.'012 for convenience since it is in English. The rejection is based on EP 0 945 310 A2 because the publication date of EP'310 (September 29, 1999) was earlier than the publication date of Pat.'012 (November 6, 2001).

Regarding claim 1, Bohn teaches a vehicle steering wheel, comprising
a skeleton 1-3 embedded in a foam casing 4 and a covering cap 6 having an edge 24
(Fig. 1),
said covering cap 6, for actuation of a horn (see lines 29-41, column 1 of Pat.'012),
being mounted so as to be *displaceable* in an axial direction (see lines 10-20, column 4 of Pat.'012),
said foam casing 4 of said skeleton 1-3 adjoining said edge 24 of said covering cap 6,

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guides 10 or 10,26 for said covering cap 6 being provided in a region of said edge 24 of said covering cap 6, said guides 10 or 10,26 being arranged such that and elastically mounted such that upon laterally pressing down said covering cap 6 for actuating said horn, said guides 10 or 10,26 are inherently tilted allowed by a yielding of said foam casing 4.

Claim 1 and other claims below are anticipated by Bohn since Bohn teaches each positive claimed element. On the other hand, note that the term, such as, "displaceable" is a relative term, particularly since virtually any thing will be displaced if enough force or pressure is applied to it. See "flexible" or "flexibility" in *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC NIII 1969). Moreover, applicant's recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claim 2, a gas bag module 5 is provided which is closed by said covering cap 6 and which together with said covering cap 6 is mounted so as to be displaceable in said axial direction, said guides 10 or 10,26 being connected with said gas bag module 5. See line 5 et seq., column 3 of Pat.'012.

Regarding claim 3, said gas bag module 5 has a cup-shaped receiving housing 17 which is open toward said covering cap 6 and adapted to receive a gas bag 16, an edge of said receiving

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housing 17 having extensions 17 (Fig. 2, see Attachment) projecting laterally outwards and toward said edge 24 of said covering cap 6, said guides 10 or 10,26 being provided on said extensions 17.

Regarding claim 4, said guides 10 or 10,26 are bolts 10 or 10,26 which are formed in one piece on said receiving housing 17.

Regarding claim 6, a detent connection 29 is provided between said skeleton 1-3 and said gas bag module 5 to support said gas bag module 5. See line 49 et seq., column 3 of Pat.'012.

Regarding claim 7, restoring springs 15 are provided, said guides are bolts 10 or 10,26 which extend through said restoring springs 15.

Regarding claim 8, bearing bushes 13 are provided, said guides are bolts 10 or 10,26 which are inserted in said bearing bushes 13, said bearing bushes 13 are fixedly mounted on said bolts 10 or 10,26 in said axial direction and are pressed into said foam casing 4.

Regarding claim 9, said guides 10 or 10,26 are received in said covering cap 6 so as to have inherently no lateral play (Figs. 1-3).

Regarding claim 10, said module 5 has a front side and said covering cap 6 covers said module 5 entirely on said front side (Figs. 1 and 2).

Regarding claim 11, said guides 10 or 10,26 are not directly connected with each other as seen in Fig. 2.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as obvious over Bohn et al. (EP 0 945 310 A2 cited by applicant).

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Regarding claim 4, Bohn teaches to form the guides of suitable synthetic material (see lines 21-31, column 4 of Pat.'012).

It is common knowledge in the art to form both Bohn's receiving housing and guides of plastic in order to save additional weight. Plastic is a notoriously well known material in the art of steering wheel as evidenced by Bohn's teachings. See *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form both Bohn's receiving housing and guides of plastic in order to save additional weight as suggested by common knowledge in the art.

8. Claim 12 is allowed.

9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

10. Applicant's arguments filed July 30, 2003 have been fully considered but they are not persuasive.

DRAWINGS

Applicant states that the drawing symbols for plastic for housing 16 has been added. However, applicant actually adds the drawing symbols for metal for housing 16 in the amended drawings. Therefore, the proposed drawing corrections have been disapproved.

35 USC 112, SECOND PARAGRAPH

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The rejection of the term "displaceable" is withdrawn in view of applicant's explicit admission that the covering cap is displaceable to the specific degree of displacement in axial direction needed to contact the electrical contacts to activate the horn.

35 USC 102(b)

The examiner agrees with applicant's statement of the law. In addition, the examiner respectfully submits that during patent examination, claims are given their broadest reasonable interpretation consistent with the specification. It is proper to use the specification to interpret what the applicant meant by a word or phrase recited in the claim. However, it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim. *In re Self*, 213 USPQ 1, 5 (CCPA 1982); *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); and *IntervetAmerica Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). Words of the claim are generally given their ordinary and customary meaning, unless it appears from the written description that they were used differently by the applicant. Where an applicant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001); *Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc.*, Fed. Cir. No.

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02-1592, 8/13/03; *E-pass Technologies, Inc. v. 3Com Corp.*, Fed. Cir. No. 02-1593, 8/20/03; and MPEP 2111.01.

Moreover, it is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "*read on*" something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are "*fully met*" by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983). 35 USC 102 reference needs not provide such explanation to anticipate when an artisan would know as evidenced by standard text book. *In re Opprecht*, 12 USPQ2d 1235 (CAFC 1989). Further, an anticipatory reference needs not duplicate word for word what it is in the claims. Anticipation can occur when a claimed limitation is "inherent" or otherwise implicit in the relevance reference. *Standard Haven Products Inc. v. Gencor Industries Inc.*, 21 USPQ2d 1321, 1328 (CAFC 1991).

In the instant case, first, applicant asserts that the patent to Bohn does not disclose or suggest the guides that, upon laterally pressing down the covering cap for actuating the horn, are tilted allowed by a yielding of the foam casing.

Applicant apparently overlooks the fact the recitation "for actuation of a horn" in claim 1 reflects a statement of intended use, purpose or objective, thus, it does not provide patentable distinguishing structure over Bohn. *In re Casey* and *In re Otto, supra*. On the other hand, Bohn describes in lines 29-41 of column 1 and lines 10-21 of column 4 that Bohn's cover cap 6 is

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movable/displaceable and parallel to the axis for actuating Bohn's horn contacts 14 and 18 (Fig. 3). When a driver presses or pushes Bohn's cover cap 6 down, Bohn's cap 6 is moved downwardly, consequently, Bohn's guides 10 or 10,26 is moved downwardly to make Bohn's switch 18 in contact with Bohn's switch 14 to actuate the horn as shown in Bohn's Fig. 3. Since Bohn's casing 6 is made of foam, thus, it is flexible and since Bohn's casing 6 and guides 10,26 are integrally connected together as transparently shown in Fig. 3, thus, if the driver applies his/her pressing force F (see Attachment) at a region of the outer edge of Bohn's casing 6, the casing 6 is inherently flexed or tilted downwardly, hence, the guide 10,26 is tilted therewith. In summary, Bohn implicitly discloses applicant's claimed functional language.

Second, applicant contends that there is no structure in the patent to Bohn that would inherently tilt the bolts when Bohn's structure is used for its intended purpose to actuate a horn. The examiner respectfully submits that Bohn does not need to expressly explain that Bohn's bolts 10,26 are inherently tilted since one having ordinary skill in the art has the reason to know or would know that Bohn's covering cap and bolts/guides are similar to applicant's covering cap and guides, *a fortiori*, they are expected to behave similarly. Indeed, when one applies a sufficient force at the region of the edge of the casing 6, said force inherently tilts or flexes the casing 6 and the bolts 10,26 therewith in the same manner shown in applicant's Figs. 4a and 4b. *In re Merck & Co., Inc.*, 231 USPQ 375 (CAFC 1986); *In re King*, 231 USPQ 136 (CAFC 1986); and *Standard Haven Products Inc. v. Gencor Industries Inc.*, *supra*.

Third, applicant asserts that:

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*The patent to Bohn et al. discloses that mounting tab 17 with dished recess 19 has a through hole 20 whose diameter is larger than the outer diameter of the mounting stud 10. This clearance is to aid in placement of the module into the foam. (Bohn et al. col. 3 lines 12-15). The patent to Bohn et al. also discloses that the mounting plate 30, (part of mounting tab 17) is the same in Figs. 1 and 2 and that the horn contacts located on the mounting tab 17 may be depressed parallel to the steering wheel axis or **may be tilted to actuate the horn switch**. (Bohn et al. col. 3 lines 42-46).*

The clearance space created by through hole 20 between mounting tab 17 and the mounting stud precludes any transfer of movement from the mounting tab to the stud 10. Thus, the stud 10 of Bohn et al. is not tilted during actuation of the horn switch.

*Even if a large force is applied to the cover cap of Bohn et al., the bolts 10 will not inherently tilt. The cover cap wall 25 at the upper portion of bolt 10 will yield before **the bolts will tilt**. The cap will yield before **the bolts will tilt** because the bolts are stabilized against tilting by virtue of a relatively large surface area contact between the flange 11 on bolt 10 and the adjacent foam plateau compared with the small surface area contact between the thin walled section 25 of cover cap and the top section of the bolt 10. Thus, claim 1 should be allowed.*

As seen in the above quoted argument, applicant expressly admits that Bohn's mounting plate 30 and mounting tab 17 may be tilted to actuate the horn switch 18, 14 as seen in Fig. 3. However, applicant concludes that the clearance space created by through hole 20 between the mounting tab 17 and the mounting stud 10 precludes any transfer of movement from the tab 17 to the stud 10. This assertion overlooks the fact that the upper part of the stud 10 is located within the guide recess 25' of the casing 6. Since the movement of the casing 6 is transmitted to the stud 10 via the guides 25', the stud 10 of Bohn is tilted when the casing 6 is tilted during actuation of the horn switch. In

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addition, applicant's arguments that "even if a large force is applied to the cover cap of Bohn et al., the bolts 10 will not inherently tilt" is apparently in direct conflict with applicant's own admission that **"the bolts will tilt"** in the above quotation. Contrary to applicant's inconsistent arguments, if a large force is applied to the cover cap of Bohn et al., the bolts 10 will inherently tilt since virtually any thing will be tilted, displaced, or collapsed if enough force or pressure is applied to it. See *Fredman v. Harris-Hub Co., Inc.*, *supra*. In this case, *Webster's II New Riverside University Dictionary* defines: "tilt: to forge with a tilt hammer." If one uses a tilt hammer to hit on Bohn's casing 6 in the direction F shown in the Attachment, the stud 10 inherently is tilted or displaced based on ordinary and customary meaning of the term.

Finally, claim 1 cannot be allowed because applicant explicitly admits that *"the cover cap wall 25 at the upper portion of bolt 10 will yield before the bolts will tilt. The cap will yield before the bolts will tilt because the bolts are stabilized against tilting by virtue of a relatively large surface area contact between the flange 11 on bolt 10 and the adjacent foam plateau compared with the small surface area contact between the thin walled section 25 of cover cap and the top section of the bolt 10."* In other words, applicant admits that Bohn's bolt/guides 10 are inherently tilted. The fact that Bohn's guides 10 are tilted before or after the casing 6 is tilted is immaterial because applicant's claim 1 does not specifically claim such steps. *Kalman v. Kimberly Clark Corp.*, *supra*. Assuming *arguendo* that claim 1 calls for such steps, note that the patentability of product-by-process is not dependent upon the process. It is well established that applicant's recitation with respect to the manner in which applicant's claimed apparatus is intended to be employed does not differentiate

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the claimed apparatus from the prior art apparatus if the prior art apparatus teaches all the structural limitations of the claims. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI 1987) and MPEP 2114.

For the reasons set forth above, the rejection of claims 1-11 is maintained.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

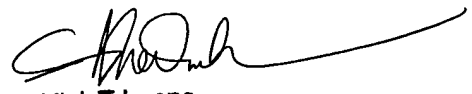
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

October 7, 2003


Vinh T. Luong
Primary Examiner

Application/Control Number: 10/083,079

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ATTACHMENT

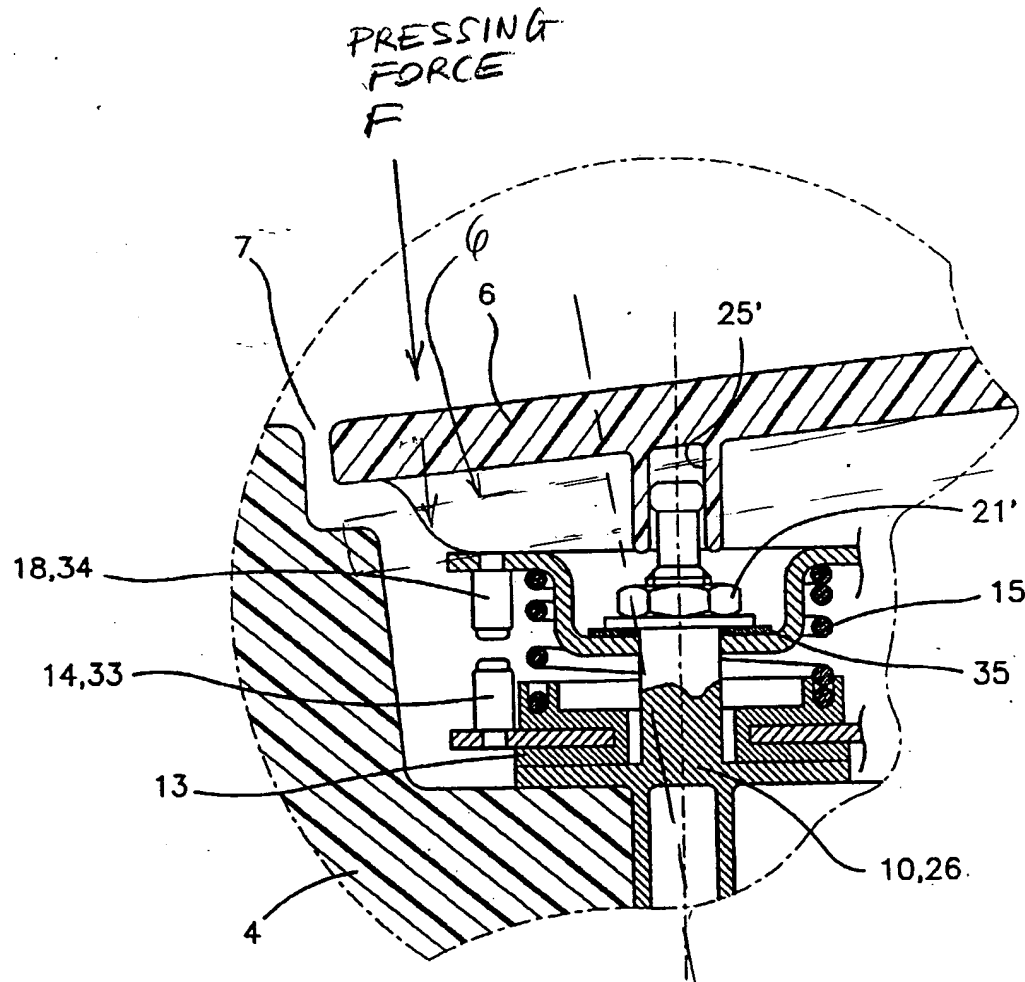


Fig.3